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EXAMINER				
COLBERT, ELLA				
ART UNIT		PAPER NUMBER		
3696				
NOTIFICATION DATE		DELIVERY MODE		
11/25/2009		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ptonotifs@yeciipaw.com

# Office Action Summary

**Application No.**

10/721,432

**Applicant(s)**

ALBAUGH ET AL.

**Examiner**

Ella Colbert

**Art Unit**

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78-80 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-80 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. Claims 78-80 are pending. Claim 78 has been amended and claims 79-80 have been added in this communication filed 07/08/09 entered as Response After Non-Final Action.
2. The Power of Attorney filed 08/13/09 has been entered.
3. The Correspondence Address Change filed 08/07/09 has been entered.
4. The 35 USC 112, First Paragraph Rejection still remains as set forth here below.
5. The 35 USC 112, Second Paragraph Rejection from the prior Office Action has been overcome by Applicants' amendment and is hereby withdrawn. However, there are still remaining 35 USC 112, Second Rejections.
6. The 35 USC 101 Rejection still remains as set forth here below.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 78 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S.

780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims XXXX fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim 78 is non-statutory under 35 USC 101 because "an agent" and "processing engine" are interpreted as software per se and not a machine or apparatus.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 78-80 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 78 recites "agent", "computer service resource" and "processing engine" which are not found in the Specification. Claims 79 and 80 have a similar issue.

The specification references consuming "pay-per-use" of equipment under lease via a unit of measure (pg. 8) and only references equipment usage through out the specification without mentioning any specific equipment.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 78 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how the rule is obtained for the plurality of records and a calculation is performed using the rule for the plurality of records because there has not been anything prior to what would cause one to obtain a rule for the plurality of records or perform a calculation using the rule for the plurality of records. If the usage data is processed into a record it is unclear how the processing takes place prior to the record being saved into a record table, etc.

It is vague and indefinite how the determination is made for a particular unit of work's status changes to a closed status. Is this determination based on the saving of the record in the record table, etc.?

The last claim limitation recites "storing the metric with the records". It is vague and indefinite what metric is being stored with the records. Do Applicants' mean the consumption of the resource for the [particular] unit of Work?

It is vague and indefinite whether a person or a computer or some device is "gathering a plurality of usage data" and "processing the usage data".

It is also vague and indefinite how the determining when a [particular] unit of work's status changes to a closed state" and what is responsive to the [particular] unit of work's status changing to the closed status". Is a person or a machine or device

making this determination and being responsive to the particular unit of work's status change?

How is a rule obtained when there is nothing related to a rule relating to the records prior to this claim limitation? Is this rule a business rule or an attribute rule or a database rule?

How is the calculating using the rule performed for each of the records? Is the calculation based on the consumption of the resource for the [particular] unit of work? Is the calculating performed by a person or a computer?

Claim 78 also recites "using the same schema". It is vague and unclear what same schema is being used.

It is unclear what makes a "unit of work" a "particular unit of work" as opposed to any other "unit of work".

"An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed ...". *In re Zletz* 13 USPQ2d 1320 (Fed. Cir. 1989).

#### ***Allowable Subject Matter***

Claims 78- 80 would be allowed if the rejections as given above were overcome.

The following is a statement of reasons for the indication of allowable subject matter: a flag in a required field of a record changing [by a processing engine] a status of a [particular] unit of work to a closed status in the unit of work table and responsive to changing the status of the [particular] unit of work to the closed status in the unit of work

table, identifying [by the processing engine] a plurality of associated records, wherein an associated record is a record associated with a unit of work..

***Response to Arguments***

Applicant's arguments filed 07/08/09 have been fully considered but they are not persuasive.

Issue no. 1: Applicants' argue: Claim 78 as amended shows the claim element and support for the claim element(s).

Response: The chart by the Applicants' showing in the figures and the specification where the claim limitations of claim 78 can be found is not considered persuasive because there is not any mention of a "processing engine", "accounting, auditing, and billing optimization process". Some of the line numbers and paragraph numbers do not match with what is in the specification that the Examiner has in the application file. Thus, the 35 USC 112, First Paragraph Rejection is maintained as set forth above.

Issue no. 2: Applicants' argue:

The Examiner stated: Karpenko discloses, A computer implemented method for processing a plurality of data into an output summarizing a consumption of a resource for a particular unit of work in an on-demand service environment, comprising: gathering a plurality of usage data, wherein each of the plurality of usage data measures a consumption of a resource in the on-demand service environment; sending the usage data to a database through a web services interface (col. 4, line 36-col. 5, line 10); processing the usage data into a raw record having a required information section and an attributes section (col. 5, lines 11 -45); saving the raw record into a record table, an

attribute table, and a unit of work table, wherein the record table is linked to the attribute table by a first key, and the record table is linked to the unit of work table by a second key (col. 6, lines 3-1 1 and col. 7, line 7-col. 8, line 58- See lines 47-55 in col. 7- a billing address, an account holder, and a currency code are attributes)); and calculating, using the rule for each of the plurality of raw records, the output summarizing the consumption of the resource for the particular unit of work (col. 10, line 56-col. 11, line 18 -performs calculations and the utility bill is the summary)); and storing the output with the raw records in the database, wherein the format of a first format of the output is the same as a second format of the raw records (col. 11, lines 36-52).

Karpenko failed to disclose, determining when a particular unit of work's status changes to a closed status, and responsive to the particular unit of work's status changing to the closed status, identifying a plurality of raw records associated with the unit of work and obtaining a rule for each of the plurality of raw records. Carpenter does not expressly disclose, determining when a particular unit of work's status changes to a closed status, and responsive to the particular unit of work's status changing to the closed status, identifying a plurality of raw records associated with the unit of work and obtaining a rule for each of the plurality of raw records. However, Carpenter does disclose workflow completion and final status (interpreted as being closed) and reading a file then displaying the results to the user in col. 62, lines 58-67. Also, Kroenke discloses in chapter 2, page 28 - tables, page 30-Fig. 2-3 (Student table); pages 32-35 and the last para. On page 40, page 41 (Fig. 2-1 0) shows a report; page 42 (fig. 2-1 1) shows developing a report with MS Access and page 48 (fig. 2-1 5 shows two related reports in



the section entitled "creating the database table". Chapter 3 pages 55-74 discuss the "Entity-Relationship Model" which includes attributes on page 56 and business rules on pages 65- para.'s 7-1 0 and 66-para. I. Chapter 5 discusses the Relational Model, pages 125, 126, 128-1 32, 134-1 36, 138-1 44, 147, 149, 150, and 152 discusses keys, attributes, and tables are linked in a E-R diagram. Therefore, it is well known in the database art to have relational diagrams, tables, attributes, keys, business rules, and databases with reports for easy access when needed. Applicant's types of tables are a design option because the tables in a database can be any type of tables. These arguments have been considered but are not persuasive because Applicants' are arguing the amendments to claim 78. Therefore, the argument is considered to be moot.

Issue no. 2: Applicants' argue: Karpenko, Carpenter, and Kroenke, individually or in combination, do not disclose the claimed invention because Karpenko is silent as to "gathering, by an agent, a plurality of usage data from a plurality of users consuming a plurality of computer resources in an on demand service environment, the on demand service environment providing a plurality of computer services available through a web service interface, wherein the agent is connected to the plurality of users, the web services interface, and the processing engine by a network, and wherein each of the plurality of usage data measures a consumption of a computer service resource in one of the plurality of computer services." Karpenko discloses a mechanical meter to read electrical consumption, and is silent as to "consumption of computer service resource." Carpenter and Kroenke are silent as to this limitation. Response: These arguments

have been considered but are not persuasive because Applicants' are arguing the amendments to claim 78. Therefore, the arguments are considered to be moot.

Issue no. 3: Applicants' argue: The cited art cannot inherently disclose the limitations because it cannot be shown to necessarily follow from the teachings of the cited art. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578,581-82, 212 USPQ 323,326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" In re Robertson, 169 F.3d 743,745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). "In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Exparte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Response: These arguments have been considered but are not persuasive because the Examiner did not use inherency as a basis for the rejection of claim 78. The express, implicit and inherent disclosures of a

prior art reference may be relied upon in the rejection of claims under 35 USC 102 or 103. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a 35 USC 103 rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775.

There is no requirement that a person of ordinary skill in the art would have recognized the inherent disclosure at the time of invention, but only that the subject matter is in fact inherent in the prior art reference. *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377, 67 USPQ2d 1664, 1668 (Fed. Cir. 2003) (rejecting the contention that inherent anticipation requires recognition by a person of ordinary skill in the art before the critical date and allowing expert testimony with respect to post-critical date clinical trials to show inherency); *Abbott Labs v. Geneva Pharms., Inc.*, 182 F.3d 1315, 1319, 51 USPQ2d 1307, 1310 (Fed. Cir. 1999) ("If a product that is offered for sale inherently possesses each of the limitations of the claims, then the invention is on sale whether or not the parties to the transaction recognize that the product possesses the claimed characteristics."); *Atlas Powder Co. v. Ireco, Inc.*, 190 F.3d 1342, 1348-49 (Fed. Cir. 1999) ("Because sufficient aeration' was inherent in the prior art, it is irrelevant that the prior art did not recognize the key aspect of [the] invention ... An inherent structure, composition, or function is not necessarily known.") >; *SmithKline Beecham Corp. v. Apotex Corp.*, 403 F.3d 1331, 1343-44, 74 USPQ2d 1398, 1406-07 (Fed. Cir. 2005) (holding that a prior art patent to an anhydrous form of compound

"inherently" anticipated the claimed hemihydrate form of the compound because practicing the process in the prior art to manufacture the anhydrous compound "inherently results in at least trace amounts of the claimed hemihydrate even if the prior art did not discuss or recognize the hemihydrate">. MPEP 2112.

"A claimed invention is unpatentable if the differences between it and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C 103(a) (2000); *KSR Int'l v. Teleflex Inc.*, 127 S. Ct. 1727, 1734, 82 USPQ2d 1285, 1391 (2007). "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *Id.* 127 S. Ct. at 1739, 82 USPQ2d at 1395.

Also, "when a work is available in one field of endeavor, design incentives and other market forces can prompt variations of it, either in the same field or in a different one. If a person of ordinary skill in the art can implement a predictable variation, 103 likely bars patentability." *Id.* 127 S. Ct. at 1740, USPQ2d at 1396.

Resort can be had to case law regarding the rational supporting the motivation for combining references as follows: "We have noted that evidence of a suggestion, teaching, or motivation to combine references may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved". *In re Dembiczak*, 50 USPQ2d 1614.

Also see, *In re Nilssen* (CAFC) 7 USPQ2d 1500 (7/13/1988). "Nilssen urges this court to establish a "reality-based" definition whereby, in effect, references may not be

combined to formulate obviousness rejections absent an express suggestion in one prior art reference to look to another specific reference. We reject that recommendation as contrary to our precedent which holds that for the purpose of combining references, those references need not explicitly suggest combining teachings, much less specific references." See, e.g., *In re Semaker*, 702 F.2d 989, 995, 217 USPQ 1, 6 (Fed. Cir. 1983); *In re McLaughlin*, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

#### **Inquiries**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741. The examiner can normally be reached on Flexible Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Trammell James can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/  
Primary Examiner, Art Unit 3696

November 16, 2009